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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,066	06/21/2001	Franz Knauseder	20551/I/JR	2541
7055	7590	11/21/2006	EXAMINER	
			SAFAVI, MICHAEL	
			ART UNIT	PAPER NUMBER
			3673	

DATE MAILED: 11/21/2006

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

MAILED

Application Number: 09/814,066

NOV 21 2006

Filing Date: June 21, 2001

Appellant(s): KNAUSEDER, FRANZ

GROUP 3600

Greenblum & Bernstein, P.L.C.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 26, 2006 appealing from the Office action mailed September 22, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,195,462	Keller et al.	4-1980
5,157,892	Ryther	10-1992
5,165,816	Parasin	11-1992
5,323,584	Scarlett	6-1994
5,678,715	Sjostedt et al.	10-1997
5,899,251	Turner	5-1999
6,004,417	Roesch et al.	12-1999
6,398,902	Robins et al.	6-2002
AT 405,560	Kaindl	9-1999
DE 29,703,962	Witex Co.	6-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 21-25, and 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 to Kaindl, (Kaindl '560), in view of German reference 29703962 to Witex Co., (Witex Co. '962), when considering any of Scarlett, Keller et al., and Turner.

Kaindl '560 discloses the configuration of attaching flat structural cladding or substrate components as recited in claims 1-20 of the instant application. Kaindl '560 does not appear to disclose any specific use of adhesive with the attaching configuration. However, Witex Co. '962 teaches utilization of a pre-applied contact adhesive between tongue and groove joints so as to establish a secure engagement between cladding panels of a substrate. Witex Co. '962 discloses a "contact glue" as well as a glue activated by heat with both disclosed as pre-applied at the factory, (see translation of Witex Co. '962 as at page 4, line 19 to page 5, line 4; page 5, line 20 to page 6, line 6; page 7, lines 10-11; and page 8, lines 2-7). And, each of Scarlett, Keller et al., and Turner teach application of an adhesive upon or within a locking joint between structural members with Scarlett, for example, teaching a desire to establish a self-locking assembly to achieve a joint which does not require independent clamping or other retention means during curing of the glue or adhesive, col. 3, lines 45-48 of

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Scarlett. See, also, col. 2, lines 24-39 of Scarlett. Scarlett also teaches, as at col. 6, lines 24-28, a desire and means to prevent unpleasant welling out of excess glue.

Therefore, to have provided the floor tile assembly of Kaindl '560 with adhesive, including a pre-applied adhesive, between and within the tongue and groove joints connecting the panels 1, 2, thus securely fastening adjacent floor tiles one to another while realizing any and all advantages of adhesives within a self-locking joint, would have constituted an obvious expedient to one of ordinary skill in the art at the time the invention was made as taught by Witex Co. '962 when considering any of Scarlett, Keller et al., and Turner.

As concerns **claim 3**, the resulting panels would be "provided with a...coating [of adhesive] in the groove areas. Lines 5-7 of claim 3 appear directed to a process particularly, with apparent recitation of an element not utilized until the panels are connected together. Otherwise, any adhesive coating would moisten the tongue and/or groove area upon application thereto.

As concerns **claim 25**, the resulting panels would have at least one of the lateral groove areas of the grooves provided with the adhesive and at least one of the sides of the tongue provided with the adhesive.

As concerns **claims 32, 33, and 35**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive.

Claims 1-3, 21-25, and 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 to Kaindl, (Kaindl '560), in view of German reference 29703962 to Witex Co., (Witex Co. '962), when considering any of Scarlett, Keller et al., and Turner as applied to claims 1-3, 21-25, and 31-35 above, and further in view of Roesch et al.

Though the limitation presented within each of claims 1, 31, and 34 to "pre-applied adhesive layer" is deemed met by the above rejection of claims , Roesch et al., for example, teach utilization and advantages of various "two component" adhesives including microencapsulatable solvent adhesives that contain polymer resin and appropriate solvents as well as polyvinyl acetate base, methyl acrylate base, epoxide base etc. with such adhesives falling into a category of "latent adhesive material that becomes active after appropriate activation" along with "an activator which induces adhesion". Roesch et al. teaches application to either one or both members being connected, col. 10, line 9. Roesch et al. further teaches application to either one or both members "prior to connection" at "another site", (i.e., teaches "a pre-applied adhesive layer" as well as "applied off site"), col. 10, lines 36-40 and col. 5, lines 54-58.

Therefore, to have provided the modified floor tile assembly of Kaindl '560 with a pre-applied two component adhesive, (including adhesive with activating substance, microencapsulated adhesive, etc.), between and within the tongue and groove joints connecting the panels 1, 2, thus securely fastening adjacent floor tiles one to another while realizing any and all advantages of such well known adhesives and particularly "two component adhesives", would have constituted an obvious expedient to one of

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ordinary skill in the art at the time the invention was made as taught by Roesch et al. The recitations to "a pre-applied adhesive layer" as well as "applied off site" have not been afforded patentable weight as being directed to process in a claim to article of manufacture. However, Roesch et al. obviously teaches application of the adhesive "prior to connection" at "another site", (i.e., teaches "a pre-applied adhesive layer" as well as "applied off site").

As concerns **claim 3**, the resulting panels would be "provided with a...coating [of adhesive] in the groove areas. Lines 5-7 of claim 3 appear directed to a process particularly, with apparent recitation of an element not utilized until the panels are connected together. Otherwise, any adhesive coating would moisten the tongue and/or groove area upon application thereto. However, the adhesive taught by Roesch et al. would read upon "latent adhesive material that becomes active after appropriate activation" as well as "coating...is applied to the panels and moistens them shortly before they are joined together and comprises an activator which induces adhesion".

As concerns **claim 25**, the resulting panels would have at least one of the lateral groove areas of the grooves provided with the adhesive and at least one of the sides of the tongue provided with the adhesive.

As concerns **claims 32, 33, and 35**, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive.

As concerns **claim 36**, the resulting panels would have at least one component of a two-component glue along a first, (or tongue), edge and at least another component of the two-component glue along a second, (or groove), edge.

Claims 32, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 to Kaindl, (Kaindl '560), in view of German reference 29703962 to Witex Co., (Witex Co. '962), when considering any of Scarlett, Keller et al. as applied to claims 1-3, 21-25, and 31-35 above, and further in view of any of Robins et al. '902, Sjostedt et al. '715, Parasin '816, and Ryther '892.

Though the limitation presented within each of claims 32, 33, and 35 appear as a presumed or desired effect which one of ordinary skill in the art would have obviously desired, each of Robins et al., Sjostedt et al., Parasin, and Ryther recognize the undesirability of excess adhesive seepage and therefore teach to abate as much as possible any undesirable effects of any possible excess adhesive seepage, col. 4, lines 11-13 of Robins et al.; col. 9, line 65 to col. 10, line 10 of Sjostedt et al.; col. 3, lines 18-20 and claim 4 of Parasin; and col. 1, lines 63-67, col. 2, lines 32-36, col. 3, lines 18-20, and col. 4, lines 33-35 of Ryther. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the modified Kaindl '560 assembly with adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus

serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as taught by any of Sjostedt et al., Parasin, and Ryther.

Claims 32, 33, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Austrian reference 405,560 to Kaindl, (Kaindl '560), in view of German reference 29703962 to Witex Co., (Witex Co. '962), when considering any of Scarlett, Keller et al., and Turner, and Turner, and further in view of Roesch et al. as applied to claims 1-3, 21-25, and 31-36 above, and further in view of any of Robins et al. '902, Sjostedt et al. '715, Parasin '816, and Ryther '892.

Though the limitation presented within each of claims 32, 33, and 35 appear as a presumed or desired effect which one of ordinary skill in the art would have obviously desired, each of Robins et al., Sjostedt et al., Parasin, and Ryther recognize the undesirability of excess adhesive seepage and therefore teach to abate as much as possible any undesirable effects of any possible excess adhesive seepage, col. 4, lines 11-13 of Robins et al.; col. 9, line 65 to col. 10, line 10 of Sjostedt et al.; col. 3, lines 18-20 and claim 4 of Parasin; and col. 1, lines 63-67, col. 2, lines 32-36, col. 3, lines 18-20, and col. 4, lines 33-35 of Ryther. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the modified Kaindl '560 assembly with adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as taught by any of Sjostedt et al., Parasin, and Ryther.

(10) Response to Argument

Appellant's arguments with respect to claims 31 and 34 appear the same as Appellant's arguments with respect to claim 1. Therefore, only arguments directed to claim 1 are being addressed.

1) With respect to Appellant's arguments against the rejection of claim 1, (found at page 8, lines 9-17 and line 17 on page 11 to line 7 on page 12 and again at line 20 on page 33 to line 6 on page 34 and page 37, lines 9-21 of the Brief):

In acknowledging that the Witex Co. '962 reference discloses a "contact glue" pre-applied at the factory, (the Witex Co. '962 reference also discloses a glue activated by heat), Appellant argues that the "pre-applied adhesive" of the instant claims is limited to that which is disclosed by U.S. Patent 4,417,028 to Azevedo. U.S. Patent 4,417,028 to Azevedo has not been entered as evidence of record. At any rate, Examiner knows of no such restrictive definition of "pre-applied adhesive" that would preclude a reading of any ordinary adhesive or particularly, that pre-applied adhesive used within the Witex Co. '962 reference. Indeed, the adhesives envisioned by the instant application include those activated by contact or "contact adhesive" as is expressed at lines 1-3 on page 6 of the instant specification. The Witex Co. '962 reference sets forth such contact adhesive as well as adhesives activated by heat. Indeed, the instant specification, (as at lines 19-23 on page 5, lines 1-5 on page 6, and lines 22 on page 8 to line 17 on page 9), also includes "physically setting cements", "contact glues", and "adhesive glues" which is met by any type adhesive.

Examiner is not aware that the term “pre-applied adhesive” must be taken to specifically define what is disclosed in U.S. patent No. 4,417,028. However, the term to “pre-applied” does not serve to establish only those adhesives described within U.S. patent No. 4,417,028. As has been set forth throughout prosecution of the instant application the term to pre-applied is taken to set forth an application, (of adhesive in this instance), prior to any other given step or procedure. This is met by the combination of references used against claims 1, 31, and 34. Examiner reasons that the term pre-applied coupled with the term adhesive as used in the art, as by U.S. patent No. 4,417,028, is meant to characterize the adhesive as “applied off-site” or applied “prior to the time of assembly” or “preapplied at the factory” and not otherwise to any specific type of adhesive. Thus, as broadly accepted, the term to “pre-applied adhesive” is met by the combination of references used against claims 1, 31, and 34 since the adhesive applied to the modified Kaindl ‘560 reference is applied prior to actual joining of the members as well as prior to the actual final assemblage of the cladding members to form a substrate, (though this is not relevant since claims 1, 31, and 34 merely set forth an adhesive upon a joint end of a cladding board which is what the modified Kaindl ‘560 reference discloses. See *In re Fessman*, 489 F.2d 742, 180 U.S.P.Q. 324 (CCPA 1974) and *In re Thorpe*, 777 F.2d 695, 227 U.S.P.Q. 964 (Fed. Cir. 1985).

Appellant’s prosecution of the instant application would seem to verify Examiner’s interpretation of the term to “pre-applied adhesive”. For example, independent claim 34 recites;

"a pre-applied first layer arranged on at least one surface of the groove at least in an area of the divergent sides and a pre-applied second layer arranged on at least one surface of the tongue at least in an area of the divergent wedge shape, wherein each of the pre-applied first and second layers comprises an adhesive layer or a pre-applied layer of a substance which activates an adhesive."

With the above claim recitation, Applicant is apparently addressing the question of whether or not the adhesive is applied prior to an ensuing step or procedure and not the particular adhesive itself. In other words, Applicant is using "pre-applied" as a modifier to establish *when* a substance has been applied, not *what* substance has been applied. Further, at page 16 in Applicant's response of June 24, 2005 Applicant argues that "Roesch does not disclose or suggest a pre-applied adhesive layer...much less, [adhesives]...which are applied off-site." Clearly, Applicant's argument have been directed to when or where the adhesive is applied and not what type of adhesive is applied.

2) With respect to Appellant's arguments against the rejection of claim 1, (found at page 9, lines 19-20 and again at line 19 on page 34 to line 8 on page 35 of the Brief):

The resulting Kaindl '560 flooring assembly would possess locking elements that help ensure that the substance on the divergent sides cannot come up and out of the connection onto the surface of the panels. Thus, the modified Kaindl '560 locking elements would serve to act as a locking device and as a device which prevents the spilling out of the adhesive substance.

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- 3) With respect to Appellant's arguments against the rejection of claim 1, (found at page 10 lines 1-8 and again at page 35, lines 9-19 of the Brief):

As stated in the specific rejections of claims 32, 33, and 35, Examiner has recognized that it would have been obvious to one having ordinary skill in the art to desire application of an adhesive so as to avoid any excess spillage to thus maintain the aesthetic integrity of the floor panel joint. Further, the Witex Co. '962 reference teaches, (as at lines 5-9 on page 5 of the translation), an application of adhesive in an amount to avoid any excess spillage onto the surrounding surface of the floor panel joint.

- 4) With respect to Appellant's arguments against the rejection of claim 1, (found at line 9 on page 10 to line 8 on page 11 and again at line 20 on page 35 to line 18 on page 36 of the Brief):

Each of Scarlett, Keller, and Turner have been applied to show and teach application of adhesive within an interlocking tongue and groove joint thus serving to establish an interlocking joint enhanced by adhesive bonding. It is not seen how "in using the glue of Scarlett in the application of the Kaindl '560 reference, an excessive quantity of glue may result..." Each of Scarlett, Keller et al., and Turner are utilized to teach gluing an interlocking tongue and groove joint. Applicant has failed to establish how the claimed product differs in kind from that of the modified Australian '560 assembly. In fact, Scarlett teaches at col. 6, lines 24-28 a desire and means to prevent unpleasant welling out of excess glue.

- 5) With respect to Appellant's arguments against the rejection of claim 1, (found at lines 19-22 on page 36 of the Brief):

One having ordinary skill in the art would certainly turn to the Roesch et al. teaching of an adhesive attachment of pipes, fittings, and connectors when determining what specific adhesives could be used in the assembly of inter-fitting structural elements. Thus, Roesch is analogous art since one of ordinary skill in the art would look to the adhesive subject matter of Roesch when attempting to establish an appropriate adhesive for glued joints. Indeed, Roesch deals with one member fitting within another.

6) With respect to Appellant's arguments against the rejection of claim 3, (beginning on page 19 and again on page 45 of the Brief):

The grooves of the individual panels of the modified Kaindl '560 assembly are provided with at least a filling, coating, covering or strand, comprising a latent adhesive material that becomes active after appropriate activation, (as is taught by Witex Co. '962 as well as Roesch et al.) with the tongues being provided with a coating or surface impregnation, a covering or strand, (i.e., by applying the adhesives taught by either of Witex Co. '962 and Roesch et al. the limitations presented at lines 2-3 and lines 4-6 of claim 3 on appeal would be met). The adhesives taught by either of Witex Co. '962 and Roesch et al. would moisten the tongue and/or groove shortly before they are joined together. And, both Witex Co. '962 and Roesch et al. teach application of adhesives that comprise an activator that induces adhesion.

7) With respect to Appellant's arguments against the rejection of claim 25, (beginning on page 22 and again on page 49 of the Brief):

Appellant's arguments against the rejection of claim 25 do not appear to add anything over Appellant's arguments against claim 3. In any event, with the "filling,

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coating, covering or strand being applied to the tongue of Kaindl '560 the limitation of "at least one of lateral groove areas of the grooves are provided with the filling, coating, covering or strand" is met. And, with the "film or covering" being applied to the tongue of Kaindl '560 the limitation of "at least one of the sides of the tongues are provided with the coating or surface impregnation" is met.

8) With respect to Appellant's arguments against the rejection of claims 32, 33, and 35, (found on pages 25-32 and again on pages 52-59 of the Brief):

As stated in the specific rejections of claims 32, 33, and 35 referenced on pages 25-32 and 52-59 of Appellant's Brief, Examiner has recognized that it would have been obvious to one having ordinary skill in the art to desire application of an adhesive so as to avoid any excess spillage to thus maintain the aesthetic integrity of the floor panel joint. Further, the Witex Co. '962 reference teaches, (as at lines 5-9 on page 5 of the translation), an application of adhesive in an amount to avoid any excess spillage onto the surrounding surface of the floor panel joint.

9) With respect to Appellant's arguments against the rejection of claim 36, (found on pages 59-62 of the Brief):

Roesch has been utilized to show and teach an application of a two component adhesive within a joint of a structural element wherein "the pre-applied first layer comprises one component of a two-component glue and wherein the pre-applied second layer comprises another component of the two-component glue." Thus, Kaindl '560 as modified presents a floor panel connection possessing the limitations of rejected claim 36. Further, one having ordinary skill in the art would certainly turn to the Roesch

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et al. teaching of an adhesive attachment of pipes, fittings, and connectors when determining what specific adhesives could be used in the assembly of inter-fitting structural elements. Thus, Roesch is analogous art since one of ordinary skill in the art would look to the adhesive subject matter of Roesch when attempting to establish an appropriate adhesive for glued joints. Indeed, Roesch deals with one member fitting within another.

10) With respect to Appellant's arguments against the rejection of claims 32, 33, and 35, (found on pages 63-72 and again on pages 73-84 of the Brief):

Each of Robins et al. '902, Sjostedt et al. '715, Parasin '816, and Ryther '892 had been utilized to suggest and teach applying an adhesive in a manner to avoid excess adhesive to spill out onto the surrounding surface of a joint assembly. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided adhesive in any quantity including an amount that would not allow for excess adhesive to spill out onto the facing, (or decorative), surface, thus serving to minimize if not completely eliminate undesirable effects of seepage of any excess adhesive as taught by any of Sjostedt et al., Parasin, and Ryther.

It has been noted that Appellant's argument against the rejection of claim 36 as presented on pages 84-87 of the Brief appears as a duplicate of Appellant's argument presented on pages 59-62 of the Brief.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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ART UNIT 354

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